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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR          | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/757,344      | 01/09/2001  | Pierre Jean Francois Layrolle | 04148-00005         | 8849             |

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EXAMINER

MICHENER, JENNIFER KOLB

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 01/10/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/757,344

Applicant(s)

LAYROLLE ET AL.

Examiner

Jennifer Kolb Michener

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 27-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 27-33 and 36-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Leitao.

Examiner maintains the rejection.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 34-35 and 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leitao.

Examiner maintains the rejection.

3. Claims 27-28 and 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li.

Examiner maintains the rejection.

7. The rejection of claims 27-28 under 35 U.S.C. 103(a) as being unpatentable over Nonami has been withdrawn.

***Response to Arguments***

8. Applicant's arguments filed 11/4/2002 have been fully considered but those made in regard to Leitao and Li are not persuasive.

Applicant argues that Leitao does not teach a bond strength, especially in light of the Kokubo reference.

It is Examiner's position that the bond strength of Leitao is inherently within the range claimed by Applicant. Leitao teaches a coated implant with a coating, wherein the coating comprises a deposit of octacalcium phosphate crystals nucleated directly on the implant from solution wherein said coating comprises magnesium, calcium, and phosphate ions and induces formation of bone cells. Because the same chemicals are nucleated onto the same pre-treated surfaces, the bond strength between the implants and coatings of Leitao and Applicant will inherently be the same. Since every other limitation of Applicant's is met by Leitao, then an intrinsic property, such as bond strength, must also be met. If Leitao's bond differs from that of Applicant's it must be due to some limitation not present in Applicant's claims. Regarding Kokubo, Examiner has withdrawn this rejection because the Kokubo reference did not meet all of the limitations of the claims. Therefore Kokubo could not inherently teach the same bond strength as Applicant or as Leitao. The different implant as taught by Kokubo can not be used to determine inherent properties of Leitao.

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Applicant argues that no reference has been provided to teach that the bond strength of Leitao is inherently within the range of Applicant's.

Examiner cites Applicant's own specification and claims. A coated implant with a coating of octacalcium phosphate crystals nucleated directly on the implant from solution to induce formation of bone cells is said to have a bond strength of 40-65 MPa. Because Leitao teaches all of the product limitations required by the claims, Leitao's product must also have the same bond strength. If it does not, then the bond strength differs due to some limitation not required by the claims.

Applicant argues that the Li reference is indefinite as the bond strength range is an open-ended variable.

Examiner maintains that Li's range of 30 MPa or greater overlaps that of Applicant's. Additionally, all other limitations of the claims are met by Li. Therefore Li inherently specifically requires the bond strength of Applicant. If the bond strength of Li is different than Applicant's range of 40-65 MPa, it must be due to some limitation not present in Applicant's claims.

### ***Conclusion***

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Kolb Michener whose telephone number is 703-306-5462. The examiner can normally be reached on Monday through Thursday and alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on 703-308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3599 for regular communications and 703-305-3599 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Jennifer Kolb Michener  
January 9, 2003



SHRIVE P. BECK  
SUPERVISORY PATENT EXAMINER  
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